REMARKS

35 U.S.C. §112 and §132 Rejections

In the Office Action, Examiner required that amendment to the specification on page 7 after line 6 submitted with the amendment paper of March 4, 2004 be cancelled for not being supported by the original disclosure. Applicant respectfully traverses Examiner's requirement as follows.

It is well established that the specification and claims of an application may be amended to include subject matter shown in the drawings. The *Manual of Patent Examining Procedure*, at §2163.06, provides that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter". See also *In re Wolfensperger*, 133 USPQ 537, 542 (CCPA 1962) which held that "[w]hatever [the drawing] does disclose may be added to the specification in words without violation of the statute and rule which prohibits "new matter"...[i]f the drawing, then contains the necessary disclosure, it can 'form the basis of a valid claim'".

In the specification, support for the amendment relating to provision of variable-length delays for the replicated data streams is clearly shown in, for example, Figures 2 and 4 of the application as originally filed. For instance, Figure 2 as originally filed shows a cell streams 56 which is delayed by a granularity in time units which is finer in granularity than time units of a transmission rate, shown on the x-axis of Figure 2 (the delay of cell streams 56 is shown as t_b). Support for the amendment to the specification may also be found at Equation 1 and its related description at page 6, line 4 through page 7, line 7 of the specification, which describe the phase delays' timing characteristics.

Accordingly, Applicant respectfully submits that the amendment to the specification filed with the paper of March 4th is supported by the original disclosure of the application as filed, and requests that the requirement under 35 U.S.C. §132 be withdrawn.

In the Action, Examiner further rejected claims 1, 6, 8, 10, 13, 18, 20, 22, 33, 44 and 45 on the basis that the subject matter conveyed in the amended claims was not described in the specification.

Applicant herein amends such claims to replace the rejected language with language clarifying that transmission of data begins at a time between boundaries of time units of a transmission rate. Exemplary support for the present amendments is provided in Figures 2 and 4 of the application as originally filed. For instance, with reference to Figure 2 transmission of a cell streams 56 is shown to begin after a delay t_b at a time between boundaries of time units of a transmission rate, which is shown on the x-axis. Additional support for the amendments is found at Equation 1 and its related description at page 6, line 4 through page 7, line 7 of the specification, which describe the phase delays' timing characteristics. Supplementary support is provided by entry of the amendment to the specification filed with the paper of March 4, 2004. Similar to the arguments for the amendments to the specification, claims which are supported by the drawings alone are proper pursuant to MPEP §2163.06 and *In re Wolfensperger*, 133 USPQ 537 (CCPA 1962). Therefore, Applicant respectfully requests that the rejection of the claims under 35 U.S.C. §112 be withdrawn, and that the present amendments be entered into the record as compliant with 35 U.S.C. §112.

35 U.S.C. 103(a)

Examiner rejected claims 1, 3, 5-10, 12, 13, 15, 17-37, 39, 40 and 43-49 on the basis of 35 U.S.C. § 102(a) in view of U.S. Patent No. 5,119,368 to Hiltner (herein "Hiltner"), having regard to U.S. Patent No. 5,119,368 to Pawelski (herein "Pawelski"). Applicant respectfully traverses the rejections as follows.

Independent claims 1, 6, 8, 10, 13, 18, 20, 22, 33, 44 and 45, as amended, define transmission of data that begins at a time between boundaries of time units of a transmission rate. Support for the amendments in the specification has been noted above. No new subject matter is added by the amendments. This feature recited in the claims is not taught by Pawelski, and as such, Applicant's claimed invention is not obvious and is novel in view of Pawelski or Hiltner whether taken alone or in combination, even if there is motivation to combine the references.

More particularly, Pawelski teaches the alignment of out-of-phase input data to a reference signal (see for example, Figure 7 and column 3, lines 41 to 54). In Pawelski, the re-aligned output data is matched to the reference signal, and transmitted at the boundary of a transmission rate, such as an output clock signal (see for example, signals 28, 30 and 32 of Figure 7 of Pawelski). Pawelski teaches only re-alignment of data such that its boundary is aligned to a boundary of the time unit of the transmission rate. Pawelski does not teach beginning transmission of a traffic stream at a time between boundaries of time units. Similarly, Hiltner does not teach this feature either. As such, Applicant respectfully submits that independent claims 1, 6, 8, 10, 13, 18, 20, 22, 33, 44 and 45, as amended, are not obvious in view of Pawelski or Hiltner.

Since all remaining claims depend directly or indirectly from such independent claims, the rejection of such dependent claims is also traversed.

Additionally, Applicant submits that there is no motivation for one of ordinary skill in the art to combine Pawelski with Hiltner to arrive at Applicant's claimed invention. Pawelski is directed to "recovering the phase of the *upstream data link* in a communication system" and its teachings are directed to the context of upstream data flow (see column 2, lines 7 to 10 of Pawelski, emphasis added). Hiltner, on the other hand, is directed to a broadcast or multi-cast, i.e., *downstream*, communication system (see for example, column 2, lines 23 to 25 and abstract of Hiltner). Hiltner and Pawelski are directed to different purposes of solving different problems, and as such there would be no motivation to combine such references. Without a motivation to combine, it is impermissible to "use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention...the suggestion to combine requirement stands as a critical safeguard against hindsight analysis", see *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted).

Finally, Applicant notes that independent claims 1, 10, 13, 44 and 45 of the subject application are directed to replicating data streams as data sources to *test* a multi-port communication device, as stated in the preambles of such claims. As noted above, nether Hiltner nor Pawelski is directed to test equipment or test signal generation. Thus, one of ordinary skill in

the art would not arrive at a method or system for *testing* a multi-port communication device as recited in such claims, even if it were permissible to combine Hiltner and Pawelski.

For at least the above reasons, Applicant respectfully submits that the claims of the subject application, as amended, are non-obvious and patentable over the Hiltner and Pawelski, and Applicant respectfully requests that the rejections to such claims under 35 U.S.C. §102(a) be withdrawn.

By way of the present response, this application is believed to be in condition for allowance and such action in due course is earnestly solicited. The Examiner is invited to contact the undersigned by telephone to discuss this case further, if necessary.

Respectfully submitted,

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Date

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